

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant: Morten MELDAL *et al.*

Title: PEG-BASED
MACROMONOMERS,
CHEMICALLY INERT POLYMERS
PREPARED THEREFROM AND
THE USE OF THESE POLYMERS
FOR ORGANIC SYNTHESIS AND
ENZYME REACTIONS

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Appl. No.: 09/787,881

Filing Date: 6/28/2001

Examiner: Ba K. Trinh

Art Unit: 1625

PETITION FROM RESTRICTION REQUIREMENT UNDER
37 CFR § 1.144 and 37 CFR § 1.181

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition the Group Director of Art Unit 1625 in compliance with 37 CFR § 1.144 and 37 CFR § 1.181 for examination of certain claims of the captioned application on the grounds that the claims have unity of invention.

Action Requested

In accordance with MPEP § 1893.03(d), 37 CFR § 1.144, and 37 CFR § 1.181, Applicants request reconsideration of the Examiner's basis for restricting the claims into Group I (claims 1-9 and 33) and Group II (claims 10-32).

Statement of Facts

1. The present National Stage U.S. application was physically filed with original claims 1-36 (the "as-filed" claims). Original claims 4, 12, and 16, of the *published* PCT claim set, however, were deleted in Applicants' preliminary amendment of March 23, 2001, and the published PCT claims were renumbered, therefore, as claims 1-33.

2. The Office's restriction requirement of October 1, 2004, however, was made on the as-filed claim set instead of the published PCT version of the claims, which were made of record during International prosecution and which accompanied the IPER. Applicants pointed out the Office's inadvertent oversight in their December 1, 2004, paper, and made an election, as required, of Group I (then, claims 1-4, 7-10, and 36).

3. In learning of this mistake, the Office kindly revised the restriction requirement in the present action dated January 13, 2005, along the following lines:

Group I: claims 1-9 and 33, drawn to a macromonomer having an oxetane as the terminated group.

Group II: claims 10-32, drawn to polymer and its use.

Due to Applicants' prior election, the Office examined revised Group I, namely claims 1-9 and 33.

4. The Office failed, however, to take into consideration Applicants' preliminary amendment of March 23, 2001, where they deleted renumbered claims 15-27 and 33, and added new claim 34.

5. For the record, therefore, Applicants consider the correct status of the claims as follows:

Claims 2-9, 28-32, and 34 are pending. Claim 1 is canceled in Applicants paper filed concurrently herewith, without prejudice or disclaimer. Claims 4, 5, 6, 7, 8, and 9 correspond to as-filed claims 5, 6, 7, 8, 9, and 10, respectively.

Claims 10-14 and 28-32 are withdrawn. Withdrawn claim 10 corresponds to as-filed claim 11. Withdrawn claims 11, 12, and 13 correspond to as-filed claims 13, 14, and 15. Withdrawn claim 14 corresponds to as-filed claim 17. Withdrawn claims 28-32 correspond to as-filed claims 32, 33, 34, and 35, respectively.

Claims 15-27 and 33 were deleted in the preliminary amendment of March 23, 2001.

Claim 34 was added in the preliminary amendment of March 23, 2001.

Argument

Due to Applicants assessment of the claims as related in the preceding subsection, claims 10, 11, 12, 13, 14, 28, 29, 30, 31, and 32 are withdrawn. Applicants request that these claims be rejoined with the examined claim set, namely to claim 2-9 and 34.

Claim 10 is a polymer that is "formed by the polymerization of" the novel macromonomer of claim 2. Claims 11-14 and 28-32 are all drawn to embodiments of this polymer. Applicants contend, therefore, that there does exist a unitary connection between the presently-claimed macromonomer and polymer.

A unitary connection does exist between the presently-claimed macromonomer and polymer. The oxetane groups of the claimed macromonomer represent the polymerizable entity of the molecule and are responsible for forming the polymer from the macromonomer. It is the remaining terminal hydroxy groups of the mono-oxetane monomer units which are present in both monomer and polymer and which form the moieties in the polymer intended to be used as attachment points on the polymer for, for example, solid-phase synthesis.

Accordingly, the polymer of present claim 10 is "formed by the polymerization" of the macromonomer of present claim 2. The polymer of claim 10 cannot be made otherwise. Accordingly, Applicants maintain that there does exist a common unitary connection between the macromonomer and the polymer and request that the polymer of claims 10-15 and 28-32 be rejoined with the macromonomer of claim 2.

The national stage application is governed by PCT unity of invention rules and, therefore, claims 10-15 and 28-32 should be rejoined with claims 2-9 and 34 because the subject matter of all of these claims share a common core structure

Section 1850 at page 1800-60 to -61 of the MANUAL OF PATENT EXAMINING PROCEDURE (original 8th edition, published August, 2001) provides that

In applying PCT Rule 13.2 to . . . national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2 . . .

Hence, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature.

In this regard, the Administrative Instructions Under the PCT, Annex B, Part 1 at page AI-63 of the MPEP, provide further guidance as to the meaning of the “special technical feature” defined in Rule 13.2. The last sentence of paragraph (b) at page AI-63 states “[t]he determination [of special technical features] is made on the contents of the claims as interpreted in light of the description and drawings (if any).”

The chemical structure depicted in claim 2 is present in the chemical structure depicted in withdrawn claim 10. Furthermore, as evidenced in the preceding subsection, there is definitely a unitary connection between the presently-claimed macromonomer of claim 2 and its polymer, claimed in claims 10-14 and 28-32.

In conclusion, Applicants respectfully request, therefore, that the restriction requirement be withdrawn and that examination on the merits be conducted on claims 2-14 and 28-34.

Should additional fees be necessary in connection with the filing of this response, or if a petition for extension of time is required for timely acceptance of same, the

Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.

Respectfully submitted,

Date May 13, 2005

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